

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert L. Bratzler et al.
Serial No.: 09/776,479
Confirmation No.: 7139
Issued: September 8, 2009
Patent No.: 7,585,847
For: IMMUNOSTIMULATORY NUCLEIC ACIDS FOR THE
TREATMENT OF ASTHMA AND ALLERGY

Examiner: N. M. Minnifield
Art Unit: 1645

Certificate of Electronic Filing Under 37 CFR 1.8

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.8(a)(4).

Dated: November 6, 2009

Electronic Signature for Michelle M. Quinn: /Michelle M. Quinn/

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37
C.F.R. 1.705(D)

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests reconsideration of the patent term adjustment (PTA) indicated on the front page of U.S. Patent No. 7585847 issued on September 8, 2009. It is respectfully requested that Applicant be granted a PTA of 647 days instead of 309 days.

Applicant previously submitted an Application for Patent Term Adjustment under 37 C.F.R. 1.705(b) on June 8, 2009 which included a statement of the facts and the required fee set forth in 37 C.F.R. 1.18(e). This Application was dismissed, in part, as being premature and granted, in part, as described in greater detail below.

In accordance with 37 C.F.R. 1.705(d), a statement of the facts and the required fee are provided herein.

1. As of the issuance of U.S. Patent No. 7585847, the correct PTA is 647 days and not 309 days as calculated by the USPTO.

2. The correct PTA of 647 days is the net USPTO delay of 1330 days minus the apparent net Applicant delay of 683 days.

3. According to the Patent Term Adjustment History downloaded from the Patent Application Information Retrieval (PAIR) system on November 6 2009 (Exhibit 1), the USPTO accorded U.S. Patent No. 7585847 a net PTA of 309 days resulting from 1001 days of USPTO delay minus 598 days of Applicant delay.

4. The difference between Applicant's PTA calculation (647 days) and the USPTO's PTA calculation (309 days) results, in part, from the USPTO's failure to issue U.S. Patent No. 7585847 within three years of its actual filing date, i.e. by February 2 2004. *See* 35 U.S.C. § 154(b)(1)(B). Applicant filed a Request for Continued Examination (RCE) on October 30 2006 which resulted in an exclusion of time from that date forward. *See* 35 U.S.C. § 154(b)(B)(i). The period of delay thus began on the first day following the three year period, February 3 2004, and ended on October 30 2006, and resulted in a USPTO delay of 1000 days. The USPTO has recognized a delay of only 671 days for this time period. *See* Exhibit 1, "PTA 36 Months" entry.

5. The response to the previously submitted Application for Patent Term Adjustment, dated August 5 2009, received from the Office of Petitions did not reconsider the delay under 37 C.F.R. 1.705(b), as it was considered premature.

6. The USPTO's PTA calculation methodology has been consistently applied by the USPTO in making all PTA calculations. Those methods, however, are contrary to the statute as detailed in the Memorandum and Order entered by the United States District Court for the District of Columbia in *Wyeth v. Dudas*, Civil Action No. 07-1492 (D.D.C. Sept. 30, 2008), in which the Court granted summary judgment holding the USPTO's PTA methodology was erroneous as a matter of law.

7. The correct PTA methodology, as determined in *Wyeth v. Dudas*, governs the USPTO's calculation of the PTA for U.S. Patent No. 7585847. Applicant's PTA methodology, as outlined above, is consistent with the correct PTA methodology determined in *Wyeth v. Dudas*.

8. The difference between Applicant's PTA calculation and the USPTO's PTA calculation also results, in part, from the submission of a series of Information Disclosure Statements on November 24 2008, November 28 2008 and February 23 2009. If considered to be supplemental replies, these submissions may result in Applicant delay of 94 days (period from November 21 2008 to February 23 2009). *See* 37 CFR § 1.704(c)(8). The Patent Term Adjustment History submitted with the previously submitted Application for Patent Term Adjustment showed only 7 days of delay (for the period from November 21 2008 to November 28 2008), and a total Applicant delay of 596 days. In response to Applicant's Application for Patent Term Adjustment, the Office of Petitions agreed with Applicant's calculation of 94 days instead of 7 days. As a result of this change, the response also calculated total Applicant delay to be 683 days.

9. Exhibit 1, however, indicates an Applicant delay of 598 days. This is inconsistent with the delay calculated by Applicant and the Office of Petitions.

10. Accordingly, the correct PTA is 647 days which is the total period of USPTO delay (1330 days) minus the total period of Applicant delay (683 days).

11. A terminal disclaimer was not filed in U.S. Patent No. 7585847 and the patent is not subject to a terminal disclaimer.

Applicant submits \$200.00 as set forth in 37 CFR § 1.18(e). If there is any additional fee occasioned by this Request that is not covered by the enclosed fee, please charge any deficiency to Deposit Account No. 23/2825.

Dated: November 6, 2009

Respectfully submitted,

By 

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